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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,248	04/09/2001	Billy F McCutchen	BB1208PCT	4178

7590

11/25/2002

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EXAMINER

GOLDBERG, JEANINE ANNE

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 11/25/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,248

Applicant(s)

MCCUTCHEN ET AL.

Examiner

Jeanine A Goldberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. This application contains a preliminary amendment which was not signed. The preliminary amendment cancelled all previously pending claims, 1-20 and added Claims 21-29. After speaking with Kenneth Joung, on November 20, 2002, Mr. Joung indicated that he did not have record of the preliminary amendment. Thus, it was agreed that the original Claims 1-20 would be restricted.

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-10, 15-20, drawn to nucleic acids, host cells, chimeric genes, virus, methods of obtaining a nucleic acid fragment. This group is subject to a further restriction (see below).

Group II, claim(s) 11, drawn to a polypeptide. This group is subject to a further restriction (see below).

Group III, claim(s) 12-14, drawn to a method of selecting an isolated polynucleotide that affects the level of expression of a polypeptide in a plant cell. This group is subject to a further restriction (see below).

3. The claims do not relate to a single inventive concept. Each of the polynucleotides and polypeptides claimed are not so linked. They fail to share common structure and functions. Therefore, there is no technical feature which links the claims.

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Furthermore, the inventions of Groups I and II are distinct products because the DNA of Group I and the protein of Group II have different structures, properties and functions. The DNA of Group I is composed of nucleotides linked in phosphodiester bonds and arranged in space as a double helix. The DNA can function not only for the expression of the protein but also as a probe in a nucleic acid hybridization assay and in a nucleic acid amplification assay, for example. In contrast, the polypeptide of Group II is composed of amino acids linked in peptide bonds and arranged spatially in a number of different tertiary structures including alpha helices, beta-pleated sheets, and hydrophobic loops (transmembrane domain). The polypeptide can function not only as a receptor but also for the generation of polyclonal and monoclonal antibodies and for the affinity purification of those antibodies or of ligands for the receptor. Moreover, group (I and II) and III are distinct inventions because the polynucleotide of Group I and the polypeptide of Group II are not relied upon in the method of Group III. Instead Group III uses nucleic acids which are not limited to those of Claim 1.

Sequence Restriction Requirement Applicable to All Groups:

4. Each sequence is patentably distinct because they are unrelated sequences, i.e. these sequences are unrelated because the protein encoded by these sequences differ in structure and in function and in biological activity. As exemplified in the "Brief Description of the Drawings", the amino acids have separately been aligned with previous known toxins from various organisms. There are seven different amino acid

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sequences of the instant application. Furthermore, as provided in the description of the Sequence Listing, pg 6, the amino acids appear to be directed to distinct toxins including, alpha toxin XIV, neurotoxin I, and depressant toxin LqhIT2. Each of these polypeptides thus appear to be different in both structure and function.

A restriction is applied to each Group. For an elected Group drawn to nucleotide sequences, the Applicants are permitted to elect a single nucleic acid sequence since the nucleic acid sequences do not encode the same protein. For an elected Group drawn to amino acid sequences, the Applicants must further elect a single amino acid sequence.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jeanine Enewold Goldberg whose telephone number is (703) 306-5817. The examiner can normally be reached Monday-Thursday from 7:00AM to 4:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax number for this Group is (703) 305- 3014.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Jeanine Enewold Goldberg
November 20, 2002


W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600